From: Guiliano, Joseph M. [mailto:JGuiliano@fishneave.com]

Sent: Friday, August 15, 2003 2:53 PM

To: 'Faile, Andrew'

Subject: RE: Harvey Applications

Dear Mr. Faile,

Thank you for the update. I look forward to hearing from you.

sincerely, Joe Guiliano

----Original Message----

From: Faile, Andrew

To: JGuiliano@fishneave.com

Sent: 8/15/2003 1:23 PM

Subject: RE: Harvey Applications

Mr. Guiliano,

We are still reviewing the request below. I'll get back with you as soon as there is an answer on this.

Sincerely, Andrew Faile

----Original Message----

From: JGuiliano@fishneave.com [mailto:JGuiliano@fishneave.com]

Sent: Thursday, August 07, 2003 1:40 PM

To: Andrew.Faile@USPTO.GOV

Subject: RE: Harvey Applications

Thank you, Mr. Faile. I look forward to hearing from you.

----Original Message----

From: Faile, Andrew [mailto:Andrew.Faile@USPTO.GOV]

Sent: Thursday, August 07, 2003 1:28 PM

To: JGuiliano@fishneave.com

Subject: RE: Harvey Applications

Mr. Guiliano,

I have received your email and certainly will consider the points therein. I hope to get back to you with a response by the end of next week.

Sincerely, Andrew Faile

----Original Message----

From: JGuiliano@fishneave.com [mailto:JGuiliano@fishneave.com]

Sent: Thursday, August 07, 2003 12:19 PM

To: andrew.faile@uspto.gov Subject: Harvey Applications Thank you for taking the time on Tuesday to discuss the status of the Harvey continuation applications. I have given careful consideration to your proposal to suspend prosecution of the continuation applications in view of the third party reexamination requests that have been filed with respect to several of the issued Harvey patents. I firmly believe that suspension of all of the applications is unnecessary and improper. The advanced state of prosecution of at least two of the 1981-based applications (INTE and MULT) and many of the 1987-based applications should permit prosecution of those applications to continue without interfering with the reexaminations. All of the pending continuation applications are to be treated as "special" under M.P.E.P. Sec. 708.01 by virtue of their effective filing dates. While it is true that reexaminations are to be given priority under M.P.E.P. Sec. 708, that is not a justification for suspending prosecution of an applicant's entire portfolio of related applications. It is particularly inappropriate in this case, where all of the pending applications are to be treated as "special," and where the record for many of the applications is very well developed and ready or almost ready for final disposition.

Moreover, suspension of prosecution is highly prejudicial and fundamentally unfair to applicants. The applications in question have been pending for over eight years. Applicants did not request reexamination of their patents. This burden was placed on the PTO by third parties who are defendants in litigation involving the Harvey patents. Their questions concerning the validity of the Harvey patents could have been addressed by the Courts. In addition, prosecution of many of these applications, including INTE and MULT, has already been suspended once before. Further suspension of these cases would be highly irregular, prejudicial and unfair, especially considering their advanced state.

Furthermore, with respect to the 1987-based applications, these cases do not even raise the Section 120 priority issue that has been a point of contention in the 1981-based cases. During the past few months, replies to recent Office actions have been filed in 17 of the 1987-based cases. These replies include narrative descriptions and detailed claim charts that demonstrate, on an element-by-element basis, that the claims are fully supported by the 1987 specification. The prior art rejections have also been thoroughly addressed (significantly, many claims were not rejected based on prior art). These detailed replies should enable the Examiners to bring closure to these cases in an efficient an prompt manner.

Suspension of the 1981 INTE and MULT applications is also inappropriate. In replies filed early this year, we provided a detailed statement of the law governing the issue of Section 120 priority. Those replies also thoroughly addressed the wholly unsupported "wiggle room", "pledge" and other theories that were improperly relied on by the Examiner to sustain a blanket denial of Section 120 priority for all claims. Significantly, in both cases, we submitted expert declarations of Dr. George T. Ligler, which provide detailed explanations of how both the 1981 and 1987 specifications support the claimed subject matter. Applicants are entitled to responses to these extensive submissions which, given the overwhelming evidence offered by

way of expert declarations and otherwise, should be allowance. If the Examiner believes he can refute this evidence, then these cases are ripe for Board review. Given the advanced state of INTE and MULT, the issue of the blanket rejection of Section 120 priority would be presented to the Board by way of these cases (if agreement cannot be reached) well before similar issues in the reexaminations are presented. Therefore, continued prosecution of INTE and MULT may actually facilitate prosecution of the reexaminations.

While applicants would strongly prefer to also move forward as quickly as possible with prosecution of the other 1981-based applications, we acknowledge that if agreement cannot be reached on the blanket denial of Section 120 priority claims in INTE and MULT, it may be more efficient to obtain Board review of INTE and MULT before proceeding with further examination of the other 1981-based cases. I therefore understand the merits of formalizing the informal agreement we had concerning prosecution of the other 1981-based cases. However, in my view, any formal suspension of the remaining 1981-based cases should terminate once the issue of the blanket priority claim denial is resolved (either by agreement or through Board review). There should be no need to wait for completion of the reexamination proceedings (if they take longer).

For the foregoing reasons, I respectfully request that you reconsider your proposal to suspend prosecution of the Harvey continuations. Instead, please consider our suggestion to move forward with prosecution of the 1987-based applications (particularly those in which replies have been recently filed), and certainly the 1981-based INTE and MULT applications.

In accordance with your request, I have attached an updated chart that reflects the current status of the pending Harvey applications. Please let me know if there is anything further we can provide to advance prosecution of the applications.

Respectfully, Joseph M. Guiliano Reg. No. 36,539

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